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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/891,581	06/27/2001	Masayuki Sakura	35.C15488	3309

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FITZPATRICK CELLA HARPER & SCINTO
30 ROCKEFELLER PLAZA
NEW YORK, NY 10112

EXAMINER

POON, KING Y

ART UNIT	PAPER NUMBER
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2624

DATE MAILED: 11/09/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/891,581

Applicant(s)

SAKURA, MASAYUKI

Examiner

King Y. Poon

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 August 2005 and 18 April 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 42-75 is/are pending in the application.
- 4a) Of the above claim(s) 60-75 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 42-59 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 27 June 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. _____.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 4/28/2005.

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. Applicant's election with traverse of restriction requirement in the reply filed on 8/19/2005 is acknowledged. The traversal is on the ground(s) that 1) two way distinctness is not seen to be presented in according to MPEP 806.05 (c) and 2) the search and examination does not present serious burden to the examiner. This is not found persuasive because:

1) MPEP 806.05(c) is for combination, subcombination or element of a combination type of restriction. The restriction of the present application is between species. Clearly, the claimed limitations of embodiment I (adding values) under disclosure are not found in the second embodiment and vice versa (adding capabilities), which meet MPEP 806.04 (f) requirement.

2) Applicant has not admitted or shown that the species (embodiment 1 and 2) are to be obvious variants. Therefore, the best reference for species I is located would require further search for species II and vice versa. Thus, creates serious burden for searching and examining if restriction is not made. Furthermore, MPEP 806.04 (e) states that claim may be restricted to a single disclosed embodiment, and Species are always the specifically different embodiments.

The requirement is still deemed proper and is therefore made FINAL.

2. This application contains claims 60-75 drawn to an invention nonelected with traverse in Paper dated 8/19/2005. A complete reply to the final rejection must include

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cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

Claim Rejections - 35 USC § 101

3. Claim 59 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claim 59 is drawn to functional descriptive material NOT claimed as residing on a computer readable medium. MPEP 2106.IV.B.1(a) (Functional Descriptive Material) states:

“Data structures not claimed as embodied in a computer-readable medium are descriptive material per se and are not statutory because they are not capable of causing functional change in the computer.”

“Such claimed data structures do not define any structural or functional interrelationships between the data structure and other claimed aspects of the invention which permit the data structure's functionality to be realized.”

Claim 59, while defining a computer program, does not define a “computer-readable medium” and is thus non-statutory for that reasons. A computer program can range from paper on which the program is written, to a program simply contemplated and memorized by a person. The examiner suggests amending the claim to embody the program on “computer-readable medium” in order to make the claim statutory.

“In contrast, a claimed computer-readable medium encoded with the data structure defines structural and functional interrelationships between the data structure and the computer software and hardware components which permit the data structure's functionality to be realized, and is thus statutory.” - MPEP 2106.IV.B.1(a)

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 42, 46, 47, 49, 50, 54, 55, 57-59 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shibusawa et al (US 6,088,120) in view of well-known prior art.

Regarding claims 42, 50, 58: Shibusawa teaches a printing system (fig. 1) which is composed of an information processing apparatus (1, fig. 1) which is connected to plural print apparatuses (2a, 2b, fig. 1), comprising: an environment setting unit (note) adapted to set a print environment (e.g., setting printer A and printer B as virtual printer or setting printer B, printer C and printer D as virtual printer, fig. 6) of print data (e.g., the print data received from 11a, 11b, etc, fig. 2), said environment setting unit including a selecting unit (note) adapted to select at least two or more print apparatuses from among the plural print apparatuses data (e.g., setting printer A and printer B as virtual printer or setting printer B, printer C and printer D as virtual printer, fig. 6); and an obtaining unit (the program code of the server that performs the step disclosed on page 5, lines 1-33) adapted to, based on printer capability description information (column 5, lines 20-25) in which a maximum value (attribute values, column 5, lines 15-20) of capability of a function of each of the plural print apparatuses is described and the print environment set by said environment setting unit, add (sum, column 5, lines 15-20) the maximum values of the capabilities of the functions of the print apparatuses selected by

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said environment setting unit to set a renewal maximum value (the attribute values of logical printer, column 5, lines 25-30), and obtain complex printer capability description information in which the set renewal maximum value is described (column 7, lines 50-67).

Note: Shibusawa does not specifically disclosed a setting unit and obtaining unit, however, it is well known in the art the program and conditions of a computer (print managing apparatus of fig. 1) is being programmed by a user/person (official notice) by using a setting unit for entering information and using selecting unit for selecting items.

Therefore, it would have been obvious to a person with ordinary skill in the art at the time the invention was made to have modified Shibusawa to include: a setting unit and a selecting unit in the system of Shibusawa for entering and selecting the physical printers to form the virtual printers.

Regarding claims 46, 54: Shibusawa teaches wherein the print environment of the print data includes types and the number of print apparatuses (fig. 7, column 5, lines 20-25), and said environment setting unit includes a unit adapted to select the type and the number of print apparatuses.

Regarding claims 47, 55: Shibusawa teaches the information processing apparatus further comprising an input operation unit adapted to be able to perform an input operation for updating the content of the printer capability description information of each of the plural print apparatuses (column 4, 50-67, column 5, lines 1-7).

Regarding claims 49, 57: Shibusawa teaches wherein the maximum value of the capability of the function of each of the plural print apparatuses is the number of output-

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permitted bins of each of the plural print apparatuses, and the renewal maximum value is the number obtained by adding together (sum, 5, lines 24-26) the number of output-permitted bins of each of the plural print apparatuses (column 6, lines 1-5).

Note: the virtual printer is programmed by a user, and not all functions are permitted to be used (column 5, lines 35-45). Therefore, the output bins of the virtual printer set up in column 6, lines 1-5 are output permitted bins.

Regarding claim 59: Claim 59 is claiming a program for controlling the method as disclosed in claims 50, 42. It is well-known in the art that a server (column 3, lines 65-67) is controlled by a program (official notice).

6. Claims 43, 44, 51, 52 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shibusawa in view of well-known prior art as applied to claim 50 above, and further in view of Rosekran et al (US 5,450,571).

Regarding claims 43, 51: Shibusawa teaches the information processing apparatus, further comprising an attribute setting unit adapted to set a print attribute of the print data (column 8, lines 10-25), wherein the setting of the print attribute by said attribute setting unit can be performed based on the renewal maximum value, based on the complex printer capability description information obtained by said obtaining unit (column 5, lines 20-27, column 6, lines 50-67).

Although Shibusawa teaches presenting renewed maximum value to a user, Shibusawa does not teach presenting the renewed maximum value on a screen.

Rosekrans, in the same area of virtual printers (column 4, lines 62), teaches presenting the renewed maximum value (virtual printer) on a screen (column 4, lines 40-45).

Therefore, it would have been obvious to a person with ordinary skill in the art at the time the invention was made to have modified Shibusawa to include: teach presenting the renewed maximum value on a screen such that a user would view the renewed maximum value.

Regarding claims 52, 44: Shibusawa teaches the information processing apparatus further comprising an indicating unit (job control portion, fig. 2) adapted to indicate print of the print data, wherein the print data print-indicated by said indicating unit is subjected to dispersion print (the print data of all print job is being subjected to dispersion print by using job output section, 14a, 14b etc, fig. 2) by the print apparatuses selected by said environment setting unit (column 4, lines 25-32).

7. Claims 45, 53 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shibusawa in view of well-known prior art and Rosekran et al (US 5,450,571) as applied to claims 44, 52 above, and in further view of Lobiondo (US 5,287,194).

Regarding claims 45, 53: Shibusawa does not teach a receiving unit adapted to receive notification of information representing how the print data has been subjected to the dispersion print.

Lobiondo, in the same area of using multiple printers for printing print data (column 4, lines 50-65), teaches a receiving unit adapted to receive notification of

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information representing how the print data has been subjected to the dispersion print (column 5, lines 10-15).

Therefore, it would have been obvious to a person with ordinary skill in the art at the time the invention was made to have modified Shibusawa to include: a receiving unit adapted to receive notification of information representing how the print data has been subjected to the dispersion print.

It would have been obvious to a person with ordinary skill in the art at the time the invention was made to have modified Shibusawa by the teaching of Lobiondo because: it would have allowed users knowing where their print jobs are being printed, and it would have allowed users to know where to look for their print jobs to save time.

8. Claims 48, 56 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shibusawa in view of well-known prior art as applied to claim 50 above, and further in view of Makishima et al (US 6,686,964).

Regarding claims 48, 56: Shibusawa does not teach wherein the maximum value of the capability of the function of each of the plural print apparatuses is the maximum number of output copies of each of the plural print apparatuses, and the renewal maximum value is the number obtained by adding together the maximum number of output copies of each of the plural print apparatuses.

Makishima, in the same area of printing using paper located in a paper tray, teaches the maximum number of print copies that a printer can produced depends on the maximum value of print sheet available (column 2, lines 20-43).

Therefore, it would have been obvious to a person with ordinary skill in the art at the time the invention was made to have modified Shibusawa to include: wherein the maximum value of the capability of the function of each of the plural print apparatuses is the maximum number of output copies of each of the plural print apparatuses, and the renewal maximum value is the number obtained by adding together the maximum number of output copies of each of the plural print apparatuses.

It would have been obvious to a person with ordinary skill in the art at the time the invention was made to have modified Shibusawa by the teaching of Makishima because it would have allowed the logical printer of Shibusawa to be properly set up such that a user would fully utilized Shibusawa's invention.

Response to Arguments

9. Applicant's arguments with respect to claims 42-59 have been considered but are moot in view of the new ground(s) of rejection. Please see detailed office action.

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not

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mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

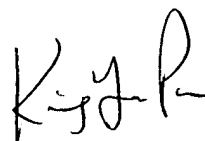
Conclusion

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to King Y. Poon whose telephone number is 571-272-7440. The examiner can normally be reached on Mon-Fri 8:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Moore can be reached on 571-272-7437. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

November 7, 2005



**KING Y. POON
PRIMARY EXAMINER**